

Patterson Belknap Webb & Tyler LLP

1133 Avenue of the Americas New York, NY 10036-6710 212.336.2000 fax 212.336.2222 www.pbwt.com

July 28, 2006

Kim J. Landsman
(212) 336-2980
Direct Fax (212) 336-2985
kjlandsman@pbwt.com

Filed Electronically

Honorable Gustave J. DiBianco
United States Magistrate Judge
United States Courthouse
PO Box 7396
100 South Clinton Street
Syracuse, New York 13261

**Re: Haritatos v. Hasbro, Inc. and Toy 'R Us-NY LLC,
Civil Action 05-CV-930**

Dear Judge DiBianco:

We are counsel for defendant Hasbro, Inc. ("Hasbro") and write in response to Mr. Purcell's July 26, 2006, letter to the Court requesting to extend the discovery deadlines, including the deadline for disclosing expert witnesses. Plaintiff seeks an extension of the deadlines to disclose an expert on U.S. trademark law and procedure on the grounds that he could not disclose his expert prior to the testimony of Defendants' witnesses. But Plaintiff has failed to explain why his expert needs the testimony of Defendants' business people to "assist the trier of fact to understand the evidence or to determine a fact in issue." Fed. R. Evid. 702.

Plaintiff appears to believe that he can present expert testimony as to trademark law and procedure, but the courts in this circuit have not allowed such testimony. "[T]he expert testimony of an attorney as to an ultimate issue of domestic law or as to the legal significance of facts is inadmissible." Motown Prod., Inc. v. Cacomm, Inc., 668 F. Supp. 285, 288-89 (S.D.N.Y. 1987), rev'd on other grounds, 849 F.2d 78 (2d Cir. 1988) (excluding affidavit of trademark lawyer opining that trademark was "suggestive"). "It is not for witnesses to instruct the jury as to applicable principles of law, but for the judge." U.S. v. Scop, 846 F.2d 135, 140 (2d Cir. 1988) (citing Marx & Co., Inc. v. Diners' Club Inc., 550 F.2d 505, 509-10 (2d Cir. 1977)). "[T]he Second Circuit applies strict standards to the admissibility of expert opinions, disagreeing with other circuits when necessary[.]" Kidder, Peabody & Co., Inc. v. IAG Int'l Acceptance Group, 14 F. Supp. 2d 391, 404 (S.D.N.Y. 1998).

Plaintiff cites a single case from a district court in Illinois for the proposition that it is "standard practice" for parties to offer expert testimony on trademark law and procedures, but the case actually refutes his position. In Sam's Wines & Liquors Inc. v. Wal-Mart Stores Inc., 32 U.S.P.Q.2d 1906, 1912 (N.D. Ill. 1994), plaintiff offered an expert to testify concerning

Honorable Gustave J. DiBianco
July 28, 2006
Page 2

"the procedures, standards, customs, usage, and practices in the United States Patent & Trademark Office ("PTO") and among in-house trademark counsel and the trademark bar." Id. The court allowed testimony on "the technical aspects of applying for and obtaining a federal trademark registration" and "the similarities of the parties' respective marks" but precluded the expert from testifying "on the legal standards applicable to this case or the results of her legal research as they apply to the ultimate issue of trademark infringement or likelihood of confusion." Id. at 1913. The procedures of the PTO are not at issue in this case and Plaintiff admits there are no similarities between the marks at issue as the parties use them, see Exhibit 1 hereto, so the case is unhelpful to him. Moreover, the testimony of Hasbro's business people is irrelevant to any such opinion.

Mr. Purcell's letter lists several proposed subjects of testimony for his expert, but the only subjects cited in Mr. Purcell's letter that might relate in any way to Hasbro's business people are "Hasbro's [alleged] efforts to acquire Plaintiff's rights in his registered trademark and whether Defendant Hasbro's activities in licensing its allegedly infringing trademark to Toys 'R Us and others were willful and in bad faith." That states the conclusion he expects from his expert but does not explain why his expert needs the testimony of Hasbro's business people. In sum, Mr. Purcell still has not explained why his client was unable to name an expert and produce an expert report within the existing deadlines.

Plaintiff has repeatedly delayed the progress of this case, first by obstructing the entry of a protective order, then by waiting until late in discovery to notice the depositions of Defendants' employees. He should not now be allowed to further delay the case when he cannot articulate a proper subject for his proposed expert's testimony or why his expert needs the testimony of Hasbro's business people to offer an expert opinion. Merely stating that his "expert's testimony will be intertwined with the unique facts of this case" is simply conclusory and unhelpful.

Accordingly, we respectfully request that the Court deny Plaintiff's motion to extend the discovery deadlines.

Respectfully submitted,



Kim J. Landsman

cc: Robert E. Purcell, Esq. (e-mail)
John G. McGowan, Esq. (e-mail)

Exhibit 1

1

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF NEW YORK

3

5 SPERO HARITATOS,

Plaintiff,

7

- VS -

Index No.:

05 CIV 930 (DNH/GJD)

8

HASBRO, INC. and

9

TOYS "R" US-NY LLC,

Defendant.

1

12

20

21

22

23

24

25

	Page 310		Page 312
1	SPERO T. HARITATOS	310	SPERO T. HARITATOS
2	happens to every witness, and it happens to a lot of		Q. They said that Hasbro's Candyland board game
3	lawyers, too.		mark looked similar to your turkey joints mark?
4	All right. Let's take a look at the jar for		A. The Candyland mark, the original Candyland.
5	your turkey joints.		It still looked like Candyland.
6	A. All right.		Q. Do you think that there's any similarity?
7	Q. Are there any similarities between the		You just testified that there is no similarity between
8	turkey joints mark and Hasbro's Candyland mark?		the two marks, correct?
9	A. No, I don't believe so.		A. Yes. I don't see it.
10	Q. Okay. They're not the same color, correct?		Q. Okay. And has anyone ever inquired about a
11	A. Correct.		relationship between your business and Toys "R" Us?
12	Q. In fact, they're written in different		A. A relationship?
13	scripts, correct?		Q. (Nodding.)
14	A. I guess so.		A. I don't believe so.
15	Q. And Hasbro uses two words in it's Candyland		Q. Has anyone ever inquired about any
16	name and you use one word in your Candyland name in		association between you and Toys "R" Us?
17	your turkey joints mark, correct?		A. I don't believe so.
18	A. Correct.		Q. Okay. And has anyone ever inquired about a
19	Q. So there's a different number of words		relationship between you and Hasbro?
20	between the two marks?		A. Except for -- no. Except for McLaughlin at
21	A. Yes.		the time.
22	Q. Okay. The overall design of the two marks		Q. Hasbro's --
23	is different, correct?		A. Hasbro's McLaughlin.
24	A. Correct.		Q. Aside from some person from Hasbro, has
25	Q. And the overall impression created by the		anyone ever inquired about a relationship between you
	Page 311		Page 313
1	SPERO T. HARITATOS	311	SPERO T. HARITATOS
2	two marks is different, correct?		and Hasbro?
3	A. Correct.		A. No.
4	Q. Okay. Has anyone ever told you that		Q. Okay. And you're not aware of anybody who
5	Hasbro's Candyland mark is similar in the way it looks		was confused about the origins of the goods that
6	to your turkey joints mark?		Toys "R" Us was selling in their candy department,
7	A. I remember a long time ago someone mentioned		right?
8	it years ago.		A. No.
9	Q. They mentioned what?		Q. Okay. You don't have any reason to believe
10	A. That it's very -- it's similar to ours.		that anyone would have been confused by the goods that
11	Q. When did this happen?		are being -- strike that.
12	A. Oh, a long time ago.		You have no reason to believe that anyone
13	Q. Ten years ago?		would have been confused about the origins of the goods
14	A. Yeah. I don't know. I don't remember.		that were being sold in the Toys "R" Us candy
15	Q. More than ten years, or less than ten		department since 2001?
16	years?		A. I can't say that. I don't know.
17	A. It could have been more than ten years.		Q. What I'm asking you, sir, is do you have any
18	Q. And who was this person?		reason to believe that anyone was confused about the
19	A. I don't know. Just a customer brought it		origin of the goods sold in Toys "R" Us candy
20	up.		department since 2001?
21	Q. Somebody who had walked into your store?		A. Well, I can't say that.
22	A. Yeah, I believe so.		Q. Do you have a reason to believe that they
23	Q. And what did they say?		would have been confused?
24	A. Nothing. That it looked very similar to		A. I don't.
25	ours.		Q. It's a "yes" or "no" question.